

REMARKS

Claims 3, 8, 68, 73, 98-100 and 103-104 are canceled without prejudice or disclaimer. Accordingly claims 1, 2, 4-7, 9-30, 66, 67, 69-72, 74-97, 101 and 102 are pending in the application.

With respect to the Election of Species Requirement issued on March 11, 2003 (Paper No. 12) Applicant notes that, at that time, all claims in the application included the limitations of an "unbiased layer," or an "unbiased metallic layer." As such no grounds existed to require election between a first species involving an unbiased metal layer and a second species involving a biased metal layer. The statement in the now-pending Office Action that "all restriction records of record are withdrawn" is thus understood to mean that Applicant's election of species II in the response filed on April 11, 2003 is moot, and all of claims 1, 2, 4-7, 9-30, 66, 67, 69-72, 74-97, 101 and 102 are now under consideration. Applicant respectfully requests prompt notification if this understanding is in error.

Claims 1-30 and 66-104 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claimed the subject matter which Applicant regard as the invention.

Claims 98, 99, 103 and 104 stand rejected for a lack of antecedent basis. Claims 98, 99, 103 and 104 have been amended to include the limitation of "an upper side." Accordingly, proper antecedent if this is now believed to exist in each of these claims, and the rejection thereof under 35 U.S.C. § 112, second paragraph, it believed to be overcome.

Claims 3, 8, 68 and 73 stand rejected as indefinite. Claims 3, 8, 68 and 73 are herewith canceled, and rejections thereof are accordingly rendered moot.

Claims 1, 66, 96-97 and 101-102 has been amended to more clearly define the invention. Claims 1 includes a unique, combination of limitations not found in the prior art including, *inter alia*, “an electrically conductive unbiased layer provided on a back side of said substrate, said layer being adapted to receive an electric charge related to unwanted voltages and electrical noise from a first region of said substrate and return an electric charge to a second different region of said substrate to maintain a uniform bias voltage throughout the substrate.” Applicant believes that this combination of limitations, along with those in the balance of the claim, provides structural limitations of definite scope. According to, the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is believed to be overcome.

In like fashion, claims 66, 96, 97, 101 and 102 contain definite structural limitations sufficient to overcome the pending rejections under 35 U.S.C. § 112, second paragraph. For example, claim 66 includes the limitations of “layer being adapted to receive an electric charge related to unwanted voltages and electrical noise from a first region of said substrate and return an electric charge to a second different region of said substrate.” claim 96 includes the limitations of “an electrical path for removing unwanted voltages and electrical noise from said substrate at a first region thereof and return said unwanted voltages and electrical noise to said substrate at a second different region thereof.”

Claim 97 includes limitations of “an electrical path thereby equalizing unwanted voltages and electrical noise on said substrate between a first region of said substrate and a second different region of said substrate.” Claims 101 and 102 include the respective limitations of an “electrically conductive unbiased layer provided on a back side of said substrate for transferring unwanted voltages and electrical noise across said substrate,” and “an electrical path between a first region of said substrate and a second region of said substrate.” Therefore, the rejections of claims claims 66, 96, 97, 101 and 102 under 35 U.S.C. § 112 are also overcome.

Applicant notes that in relation to claim 96 the Amendment filed on November 25, 2003 includes the statement that "Osorio does not describe adhesive 48 as electrically connecting the substrate (die 46) to anything." On further consideration, this appears to be an overstatement.

The Osorio specification states "The backside 20 of the semiconductor die 12 is electrically connected to the power supply terminal (not shown). Semiconductor die 12 is directly bonded to the metal base 16 with an electrically conductive adhesive 22. Electrically conductive adhesive 22 can be, but not limited to, a silver-filled die attach epoxy or the like. This method of attachment serves to electrically connect the metal base 16 to the power supply terminal (not shown)." Therefore, it may not properly be said "Osorio does not describe adhesive 48 as electrically connecting the substrate (die 46) to anything."

Claim 96 now includes the limitations of "an electrical path for removing unwanted voltages and electrical noise from said substrate at a first region thereof and return said unwanted voltages and electrical noise to said substrate at a second different region thereof." Accordingly, claim 96 is believed to be patentably distinguishable over Osorio.

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In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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